

REMARKS

Currently Pending Claims

Claims 1-9 and 13 are currently pending in this application. As will be discussed hereinafter, claims 1, 4, 7-8 and 13 have been amended. Product claim 10 drawn to the catalyst has been canceled.

The Final Office Action

Claims 1-2, 4, 7-8, 10 and 13 have been objected to because of certain informalities, as will be discussed herein. Claims 6-9 are allowed. Claim 13 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and intervening claim 3. Claims 1-3, 5 and 10 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 5,817,424 to Ohmi. Reconsideration of this rejection and of the objections is hereby requested.

Discussion of Claim Objections

The Examiner has objected to claims 1-2, 4, 7-8, 10 and 13 in view of the informalities identified in Paragraph 3 of the subject Office Action. The amendments as set forth in Paragraph 3A, D, F-G, I, K and M have been incorporated into the claims as now amended, as can be seen in the respective amended claims.

All of the other claim objections which have not been incorporated into the claims as amended concern the same issue. More particularly, as can be seen in Paragraph 3B, the Examiner's position is that inclusion of the "form" for the catalyst is unnecessary because the term "an iron source" in the claim is clear and understood. While applicants are amenable to deleting the term "form" as well as the associated terminology, it is respectfully submitted that the term "form" is not redundant simply because "an iron source" is included in the claim and is considered by the Examiner to be clear and understood. Specifically, the subject specification separately describes the "source of iron" and the "form." As to the source of the iron, this is discussed in the specification at page 3, lines 5-11. The "source of iron" (col. 3, l. 10) can be, as illustrative preferred examples, pig iron containing about 2% by weight or more of carbon, and steel containing carbon less than about 2% by weight. In contrast, the "form" or shape of the iron used varies, depending upon the manner in which the catalyst is used (see the specification, page 3, lines 13-18). Where the catalyst is packed in a column, a particulate or powdered form is preferred. When used as a reaction pipe, a pipe is used.

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NO
→ In summary, so as use the claim terminology consistent with the specification, applicants submit that the terms "form" and "source" should be retained in the claims to provide such consistency. Nevertheless, and given the explanation herein, applicants are amenable to amending the claims in issue as set forth in Paragraph 3B-C, E, H, J and L, if the Examiner remains of the view that such claim amendments are in fact desirable and/or necessary.

Discussion of the Rejection Under 35 U.S.C. § 102(e)

The Office has maintained the rejection of claims 1-3, 5 and 10 under 35 U.S.C. § 102(e) as being anticipated by U.S. 5,817,424 to Ohmi (Ohmi '424). In Paragraph 7, the Office states that, while Ohmi teaches to form a passive oxide film layer on the surface of the steel pipe (or iron pipe), the oxide film layer formed on the surface of the steel pipe as disclosed by the reference is not being excluded from the claimed process. The fact is that Ohmi clearly teaches exposing the same iron source to the same treatment conditions, thus provides for the same process.

First of all, applicants are no longer claiming a "catalyst." Specifically, claim 10 drawn to the catalyst has been canceled. Applicants reserve the right to file a further application directed to the catalyst itself.

Thus, all pending claims are directed to a method of producing a hydrocyanic acid synthesis catalyst as the Examiner acknowledges. And, whether the oxide film layer formed by following the Ohmi process is excluded from the subject claims or not, should be immaterial to a method claim.

→ What is material and what is necessary to resolve the issue of whether the Ohmi '424 patent anticipates the subject method claims or not involves determining whether or not the Ohmi patent discloses all of the steps set forth in the subject method claims. In this regard, the Examiner has correctly noted that the Ohmi prior art does not disclose or fairly suggest a method for producing a hydrocyanic acid synthesis catalyst requiring sequentially exposing the iron surface to oxidative and reductive atmospheres for at least 10 cycles (as in claim 13). Indeed, even further, the Ohmi '424 patent does not disclose or fairly suggest any such method, as in claim 3, wherein the cycle of exposure to oxidative and reductive atmospheres is carried out more than once. It is accordingly submitted that claim 3 cannot appropriately be considered as being anticipated by the Ohmi '424 patent.

→ In fact, what is being ignored, it is respectfully submitted, is that independent claim 1 requires sequentially exposing the iron surface to oxidative and reductive atmospheres. There is no sequential exposure suggested in the Ohmi '424 patent. Indeed, Ohmi '424

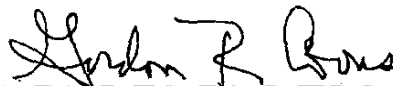
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describes a process in which the steel pipe is simultaneously exposed to oxidative and reductive atmospheres. For this reason alone, independent claim 1 and those claims dependent thereon cannot be considered as being fairly anticipated by Ohmi '424. Even further, the first step of independent claim 1 requires "selecting" an iron source and form "for the hydrocyanic acid synthesis catalyst." There is no corresponding selecting step involved in the Ohmi '424 patent; rather, the Ohmi '424 patent involves selecting a steel for forming a passive oxide film based on chromium oxide, apparently for some semiconductor applications. There is no disclosure whatever as to selecting an iron source and form for a hydrocyanic acid synthesis catalyst. For this further reason, it is respectfully submitted that Ohmi '424 neither anticipates independent claim 1 nor the rejected claims dependent thereon (specifically claims 2-3 and 5).

Conclusion

The Examiner's statement that claims 4 and 6-9 are allowable is appreciated, as is the indication that claim 13 would be allowable if rewritten in independent form as hereinbefore discussed. As to the other remaining claims, it is believed that these are patentable and that the application is in good and proper form for allowance. The Examiner is accordingly respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Gordon R. Coons, Reg. No. 20821
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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